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09/977,832	10/15/2001	Guanglu Wang	01-1013	4510

7590 02/09/2006  
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EXAMINER

JEAN GILLES, JUDE

ART UNIT PAPER NUMBER

2143

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/977,832

Applicant(s)

WANG ET AL.

Examiner

Jude J. Jean-Gilles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 15-17 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-10 and 15-17 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/20/2005.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

This Action is in regards to the Reply received on 11/10/2005.

***Response to Amendment***

1. This action is responsive to the RCE application filed on 11/10/2005. Claims 11-14 have been deleted. Claims 1, 6, 15, 16, and 17 have been amended. Claims 1-10, and 15-17 are pending, and represent a method and system for a "sidebar functionality in a regular conference system".

***Response to Arguments***

Applicant's arguments with respect to claims 1, 6, 15, 16, and 17 have been carefully considered, but are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following new ground of rejection as explained here below, necessitated by Applicant substantial amendment (i.e., a method for transmitting a SIP INVITE message to a call conference server requesting a temporary call conference wherein the SIP INVITE message indicates that the audio from the call conference should be a talk only participant in the temporary call conference) to the claims which significantly affected the scope thereof.

***Information Disclosure Statement***

2. The references listed on the Information Disclosure Statement submitted on 12/20/2005 have been considered by the examiner (see attached PTO-1449A).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claim 1-10, and 15-17** are rejected under 35 U.S.C. 102(e) as being unpatentable by Lamb et al (Lamb) U.S. Patent No. 6,747,970 B1.

**Regarding claim 1:** Lamb discloses a method of sidebar conferencing, the method comprising:

establishing a call conference between a first user, the first user having an audio stream, and a second user, the second user having an audio stream, the call conference having an audio stream (column 33, lines 58-67; column 34, lines 1-52);

creating a temporary call conference by transmitting a SIP INVITE message to a call conference server requesting a temporary call conference wherein the SIP INVITE message indicates that the audio from the call conference should be a talk only participant in the temporary call conference (column 55, lines 44-67; column 56; lines 1-65; note that the SIP-INVITE message is inherent to the SIP protocol disclosed in column 42, lines 62-67, and column 43, lines 1-6);

directing the audio stream of the call conference to the temporary call conference by transmitting a first SIP-RE-INVITE message to the call conference server indicating that the server should receive audio from the call conference(column 55, lines 44-67; column 56; lines 1-65; note that the RE-INVITE message is inherent to the SIP protocol disclosed in column 42, lines 62-67, and column43, lines 1-6);and

directing the audio stream of the first user to the temporary call conference and directing the audio stream of the second user to the temporary call conference by transmitting second and third SIP-RE-INVITE message to the first and second user-respectively wherein the audio stream of the first user and the audio stream of the second user are only audible to the first user and the second user (column 55, lines 44-67; column 56; lines 1-65; note that the RE-INVITE message is inherent to the SIP protocol disclosed in column 42, lines 62-67, and column43, lines 1-6).

**Regarding claims 2, and 7:** The combination Hirni- Beyda discloses the method of claim 1 and the system of claim 6, further comprising prompting the first user for information indicating the identity of the second user (column 50, lines 29-51).

**Regarding claims 3, and 8:** The combination Hirni- Beyda teaches the method of claim 2, and the system of claim 7, wherein prompting the user includes presenting a menu to the user (column 54, lines 17-41).

**Regarding claim 4, and 9:** The combination Hirni- Beyda teaches the method of claim 2, and the system of claim 7 further comprising receiving and processing voice commands from the first user (column 23, lines 15-23).

**Regarding claim 5, and 10:** The combination Hirni- Beyda teaches the method of claim 1, and the system of claim 6, further comprising determining whether the second user desires to enter the sidebar with the first user (column 55, lines 44-67; column 56; lines 1-65).

**Regarding claim 6:** The combination Hirni- Beyda discloses a device for conducting a sidebar conference between a first user and a second user, the device comprising:

means for establishing a call conference between a first user, the first user having an audio stream, and a second user, the second user having an audio stream, the conference having an audio stream (column 33, lines 58-67; column 34, lines 1-52);

means for creating a temporary call conference by transmitting a SIP INVITE message to a call conference server requesting a temporary call conference wherein the SIP INVITE message indicates that the audio from the call conference should be a talk only participant in the temporary call conference(column 55, lines 44-67; column 56; lines 1-65; note that the SIP-INVITE message is inherent to the SIP protocol disclosed in column 42, lines 62-67, and column43, lines 1-6);

means for directing the audio stream of the call conference to the temporary call conference by transmitting a first SIP-RE-INVITE message to the call conference server indicating that the server should receive audio from the call conference (column 55, lines 44-67; column 56; lines 1-65; note that the RE-INVITE message is inherent to the SIP protocol disclosed in column 42, lines 62-67, and column43, lines 1-6); and

means for directing the audio stream of the first user to the temporary call conference and directing the audio stream of the second user to the temporary call conference by transmitting second and third SIP-REINVITE message to the first and second user- respectively wherein the audio stream of the first user and the audio stream of the second user are only audible to the first user and the second user (column 55, lines 44-67; column 56; lines 1-65; note that the RE-INVITE message is inherent to the SIP protocol disclosed in column 42, lines 62-67, and column 43, lines 1-6).

**Regarding claim 15:** The combination Hirni- Beyda teaches a method for establishing a sidebar conference between a first user and a second user, within a on-going conference, the on-going conference having an audio stream, the first user having an audio stream, the second user having an audio stream (column 33, lines 58-67; column 34, lines 1-52), the method comprising the steps of:

directing the audio stream of the call conference to the temporary call conference by transmitting a first SIP-RE-INVITE message to the call conference server indicating that the server should receive audio from the call conference (column 55, lines 44-67; column 56; lines 1-65; note that the RE-INVITE message is inherent to the SIP protocol disclosed in column 42, lines 62-67, and column 43, lines 1-6); and

directing the audio stream of the first user to the temporary call conference and directing the audio stream of the second user to the temporary call conference by transmitting second and third SIP-REINVITE message to the first and second user- respectively wherein the audio stream of the first user and the audio stream of the second user are only audible to the first user and the second user (column 55, lines 44-

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67; column 56; lines 1-65; note that the RE-INVITE message is inherent to the SIP protocol disclosed in column 42, lines 62-67, and column 43, lines 1-6).

**Regarding claim 16:** The combination Hirni- Beyda teaches a computer program for establishing a sidebar conference [see Beyda; *fig. 1, items 30*], the program comprising:

first code for establishing a conference between a first user, the first user having an audio stream, and a second user, the second user having an audio stream, the conference having an audio stream (column 33, lines 58-67; column 34, lines 1-52);

second code for creating a temporary conference by generating a SIP-INVITE message to a call conference server requesting a temporary call conference, wherein the SIP INVITE message indicates that the audio from the call conference should be a talk only participating in the temporary call conference (column 55, lines 44-67; column 56; lines 1-65; note that the SIP-INVITE message is inherent to the SIP protocol disclosed in column 42, lines 62-67, and column 43, lines 1-6);

third code for directing the audio stream of the conference to the sidebar conference by transmitting a first SIP-RE-INVITE message to the call conference server indicating that the server should receive audio from the call conference (column 55, lines 44-67; column 56; lines 1-65; note that the RE-INVITE message is inherent to the SIP protocol disclosed in column 42, lines 62-67, and column 43, lines 1-6); and

fourth code for directing the audio stream of the first user to the temporary call conference and directing the audio stream of the second user to the temporary call conference by transmitting second and third SIP-REINVITE message to the first and



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second user- respectively wherein the audio stream of the first user and the audio stream of the second user are only audible to the first user and the second user (column 55, lines 44-67; column 56; lines 1-65; note that the RE-INVITE message is inherent to the SIP protocol disclosed in column 42, lines 62-67, and column 43, lines 1-6).

**Regarding claim 17:** The combination Hirni- Beyda teaches a computer readable medium having stored therein instructions for causing a processing unit to execute the following method :

establishing a conference, between a first user, the first user having an audio stream, and a second user, the second user having an audio stream, the conference having an audio stream(column 33, lines 58-67; column 34, lines 1-52);

creating a temporary conference by generating a SIP-INVITE message to a call conference server requesting a temporary call conference, wherein the SIP INVITE message indicates that the audio from the call conference should be a talk only participating in the temporary call conference (column 55, lines 44-67; column 56; lines 1-65; note that the SIP-INVITE message is inherent to the SIP protocol disclosed in column 42, lines 62-67, and column 43, lines 1-6);

directing the audio stream of the conference to the sidebar conference by transmitting a first SIP-RE-INVITE message to the call conference server indicating that the server should receive audio from the call conference (column 55, lines 44-67; column 56; lines 1-65; note that the RE-INVITE message is inherent to the SIP protocol disclosed in column 42, lines 62-67, and column 43, lines 1-6); and

directing the audio stream of the first user to the temporary call conference and directing the audio stream of the second user to the temporary call conference by transmitting second and third SIP-REINVITE message to the first and second user- respectively wherein the audio stream of the first user and the audio stream of the second user are only audible to the first user and the second user (column 55, lines 44-67; column 56; lines 1-65; note that the RE-INVITE message is inherent to the SIP protocol disclosed in column 42, lines 62-67, and column 43, lines 1-6).

***Important References Cited***

6. Lamb et al U.S. Patent No. 6,747,970 B1.

Pinard et al US Patent No. 5,533,110. Note that the Pinard patents also anticipate all claim limitations of this application.

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***Conclusion***

7. **THIS ACTION IS MADE NON\_ FINAL.** Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3719.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Jude Jean-Gilles

Patent Examiner

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JJG



January 27, 2006



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